

42390P0744C2

PATENT

REMARKS

Claims 21-37 and 39-41 of the application stand rejected. Claim 36 has been amended herein to more clearly define the scope of the presently claimed invention. Applicant respectfully requests reconsideration of pending Claims 21-37 and 39-41 in light of the amendments and remarks herein.

Specification

The Examiner objected to the specification because (i) the Abstract of the application exceeds 150 words in length and (ii) the placement of the section "Field of the Invention" is allegedly wrong. Applicant respectfully submits that the replacement Abstract as submitted herein overcomes the Examiner's objection to the Abstract. Applicant respectfully submits that the Abstract contains no new matter and is within the 150 word restriction. As such, Applicant respectfully requests the Examiner to withdraw the rejection to the Abstract. With respect to the "Field of the Invention", Applicant respectfully submits that this section has been deleted from the specification. As such, Applicant respectfully requests the Examiner to withdraw the rejection to the placement of the "Field of the Invention" heading.

Double patenting

Again, the Examiner rejected Claims 21-37 and 39-41 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 10-18 of U.S. Patent No. 6,138,273. Without conceding the appropriateness of the rejection, Applicant hereby reiterates a willingness to file a terminal disclaimer in order to address this rejection. Such a terminal disclaimer would be inappropriate, however, until Applicant receives from the Examiner an indication that at least one claim in the present case would be otherwise allowed. Barring such an allowance, Applicant has no reason or requirement to file a terminal disclaimer.

42390P0744C2

PATENT

35 U.S.C. §101

Claims 36-37 and 39-41 stand rejected under 35 U.S.C. § 101 because the Examiner submits that the claimed invention is directed to non-statutory subject matter. Specifically, the Examiner suggests that “translating source code instructions to generate a subroutine address without an intermediate translation” is merely a “preemption of an abstract idea or a natural phenomena without prodding a useful, concrete and tangible result”. Applicant fails to understand the Examiner’s rationale and traverses the rejection. Claims 36-37 and 39-41 are clearly directed to a method implemented on a data processing platform to translate source code. Although Applicant does not fully understand the Examiner’s concern, in the interest of moving forward with substantive examination of the application, Applicant has amended Claim 36 to clarify that Claims 36-37 and 39-41 are directed to a “method implemented on a data processing platform”. The method clearly produces a useful, concrete and tangible result, i.e., “generating a subroutine address”. As such, Applicant respectfully requests the Examiner to withdraw the 35 U.S.C. § 101, second paragraph, rejection to Claims 36-37 and 38-41.

35 U.S.C. §112

Claims 36-37 and 39-41 stand rejected under 35 U.S.C. §112, first paragraph, as based on a disclosure which is not enabling. The Examiner suggests that the lack of critical or essential element for how to perform the method for translation and the combination of this critical or essential element to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. Additionally Claims 36-37 and 39-41 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner appears to take exception to the fact that Claim 36 does not have a preamble. Applicant respectfully traverses the Examiner’s rejections under 35 U.S.C. §112, first and second paragraphs.

With respect to the 35 U.S.C. §112, first paragraph, rejection, Applicant respectfully submits that the disclosure fully enables the claimed method of translation. The Examiner appears to be suggesting the claims themselves need to explain how to perform the method for translation and Applicant respectfully disagrees. Claim 36, as

42390P0744C2

PATENT

amended, recites a novel translation method, namely “translating a source code instruction to generate a subroutine address without an intermediate translation”. This claim element is supported by the specification (e.g., see heading “Operation of the Preferred Embodiment”). Applicant respectfully requests the Examiner to explain how the pages and pages of description under this heading in the specification does not enable one of ordinary skill in the art to implement the claim elements. The Examiner’s bare allegations that the description does not support the claim element is without basis and Applicant is unable to make any further response to it at this time. Applicant thus respectfully requests the Examiner to provide additional support for this rejection or to withdraw the 35 U.S.C. §112, first paragraph, rejection.

With respect to the 35 U.S.C. §112, second paragraph, rejection, Applicant respectfully suggest that Claim 36 does indeed have a preamble (“A method implemented on a data processing system”) and that the Examiner has absolutely no support for the contention that the preamble is required to include further detail. Applicant therefore respectfully invites the Examiner to provide further support for this contention, or to withdraw the 35 U.S.C. §112, second paragraph, rejection.

35 U.S.C. §102

Claims 21-37 and 39-41 stand rejected under 35 U.S.C. § 102(b) as anticipated by Richard Gabriel (Performance and Evaluation of Lisp Systems, MIT Press, August 1985, hereafter “Gabriel”). The Examiner submits that Gabriel discloses all the elements of these claims. Applicant respectfully traverses the rejection.

As a preliminary matter, Applicant respectfully submits that the rejection of Claims 21-37 and 39-41 is facially deficient because the Examiner has not established a *prima facie* case of anticipation. As is well-established, in order to establish a *prima facie* case of anticipation under 35 U.S.C. § 102, the cited prior art must teach or suggest every limitation of the claims being rejected. Therefore, if even one claim element or limitation is not taught or suggested by the combination of references, a *prima facie* case is not established. Additionally, as the Federal Circuit has noted,

42390P0744C2

PATENT

"As adapted to ex parte procedure, Graham [v. John Deere Co.] is interpreted as continuing to place the burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103."

In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)) (emphasis added). The Examiner thus has the burden of producing a factual basis for his rejection and for establishing anticipation by identifying how each recited claim element is allegedly disclosed by the cited reference(s).

In the present case, the Examiner provides a general description of what Gabriel allegedly teaches, and then simply lists the claim elements with a page number in Gabriel. In other words, the Examiner makes no actual showing of how the sections of Gabriel in the pages cited relate to the claim element. By way of example, the Examiner lists an element of Claim 21, i.e. "encode the literal source code macroinstruction into a corresponding subroutine address without an intermediate translation" and then simply points to "(use function call, p. 35)" (which Applicant interprets to refer to a section of Gabriel on page 35). Without evaluating the substance of this section of Gabriel at this time, Applicant respectfully submits that this statement is insufficient to establish a *prima facie* case of Gabriel disclosing this claim element. In other words, the Examiner has failed to make a factual showing of how this section of Gabriel on page 35 has any relevance to the claim element. Each and every claim element (and the other claims) suffers from the same deficiency, i.e., the Examiner has merely provided bare allegations that Gabriel anticipates the claims. The Examiner has simply failed to establish a *prima facie* case of anticipation based on Gabriel and the rejection of Claims 21-37 and 39-41 should therefore be withdrawn for at least this reason.

The lack of a *prima facie* case notwithstanding, Applicant nonetheless respectfully submits that Gabriel simply does not disclose the elements of Claims 21-37 and 39-41. Since the Examiner has not put forth a complete showing of how Gabriel discloses each and every one of the claim elements, Applicant is unable to respond to any of the Examiner's concerns. Applicant is thus forced to rely on Applicant's own reading of Gabriel and Applicant fails to see how Gabriel discloses the claimed elements of receiving a literal source code macroinstruction, encoding the literal source code

42390P0744C2

PATENT

macroinstruction into a corresponding subroutine address without an intermediate translation, generating an execution stream, and storing the subroutine address. For example, as previously discussed, with respect to the element of "encoding the literal source code macroinstruction into a corresponding subroutine address without an intermediate translation" in Claim 21, the Examiner points simply to "use function call, p. 35". If Applicant interprets this to mean that the Examiner is referring to the heading "2.2.1.1. Function Call" on page 35 of Gabriel, Applicant still fails to see where Gabriel discloses this element. This section of Gabriel reads as follows:

"The CADR uses an inverted calling sequence for function calls. The CALL instruction opens a stack frame (the maximum size is 128 words). Then when the caller pushes arguments on the stack, they are placed where the callee expects them. This avoids the overhead of copying the arguments. The last argument value is moved to the destination D-LAST, which executes the function call"

Gabriel, page 35, section 2.2.1.1.

Applicant is at a loss to understand how this section teaches this claim element. Nothing in this section may be interpreted as "without an intermediate translation" and the Examiner makes no showing otherwise. The "CADR" is described in Gabriel as a "32-bit microprocessor with up to 16k of 48-bit words of writable control store and a 180-nanosecond microcycle time" (Gabriel, page 34). The section highlighted by the Examiner describes how the CADR performs function calls and nothing more. Again, Applicant stresses that nothing in this section appears to be relevant to the elements claimed herein. The Examiner makes repeated reference to this section of Gabriel, without explaining further how or why this section is relevant to any elements of Claims 21-37 and 39-41.

Similarly, with respect to Claims 36, 37 and 39-412, the Examiner refers to p20-21 of Gabriel and suggests that the "word INTERPRETER" teaches the element of "translating a source code instruction to generate a subroutine address without an intermediate translation". Again, Applicant respectfully submits that the Examiner simply cannot make a sweeping statement, i.e., that the use of the word INTERPRETER somehow teaches an entire claim element. Applicant simply cannot respond to such an unsupported statement. At best, Applicant respectfully submits that the single word INTERPRETER has no meaning other than referring to an interpretive engine. It has no other implications of whether or not there it performs intermediate translation. If

42390P0744C2

PATENT

anything, interpreters at the time of the invention typically transposed programming language into pseudocode, as described in the specification (See e.g., Summary of the Invention in the specification). This section of Gabriel is thus irrelevant to the claim elements.

In summary, Applicant respectfully contends that Gabriel does not teach at least some of these claimed elements (e.g., at least the elements of encoding the literal source code macroinstruction into a corresponding subroutine address without an intermediate translation). Applicant therefore respectfully submits that Gabriel does not anticipate Claims 21-37 and 39-41 and requests the Examiner to withdraw the rejection to these claims under 35 U.S.C. §102.

42390P0744C2

PATENT

CONCLUSION

Based on the foregoing, Applicant respectfully submits that the applicable objections and rejections have been overcome and that pending Claims 21-37 and 39-41 are in condition for allowance. Applicant therefore respectfully requests an early issuance of a Notice of Allowance in this case. If the Examiner has any questions, the Examiner is invited to contact the undersigned at (714) 669-1261.

If there are any additional charges, please charge Deposit Account No. 50-0221.

Respectfully submitted,

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